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Date: September 3, 2009

By /Jennifer Archer/
Jennifer Archer

Attorney Docket No. 100727-63 KGB
Confirmation No. 1315

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Christian GARTNER et al
SERIAL NO. : 10/770,708
CUSTOMER NO. : 27384
FILED : February 3, 2004
FOR : DEVICE AND METHOD FOR MANUFACTURING DENTAL PROSTHESIS
ART UNIT : 3732
EXAMINER : Sunil K. Singh

September 3, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

SIR:

In response to the restriction requirement dated August 3, 2009, Applicants hereby elect with traverse to prosecute the subject matter of Group II, claims 19-26, drawn to method of manufacturing a dental prosthesis.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants expressly reserve the right to prosecute the non-elected subject matter in a divisional application should it prove necessary to do so.

With respect to the traversal, Applicants respectfully submit that the Examiner has not established a serious search burden in continuing to examine both grouped sets of claims in this single application. *Manual of Patent Examining Procedure* § 803 is entitled “Restriction — When Proper” and provides in pertinent part:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

* * *

“There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent * * * or distinct as claimed * * *; and
- (2) There must be a serious burden on the examiner if restriction is not required * * *. [All emphasis added.]”

Consequently, the Examiner’s authority to insist upon restriction only extends to those situations where the failure to insist upon restriction would subject the Examiner to serious burden.

On the present record, the Examiner has not established that the examination of the two grouped sets of claims would subject him to a serious search burden. The Examiner alleges the

need to search different classes/subclasses or electronic resources, etc. However, the fact of the matter is the Examiner has already conducted the main search. Thus, the claims between which restriction is now required are the same claims that were pending when the Examiner issued the Office Action dated October 23, 2008. The Examiner could not have issued that Office Action unless he had already examined the full scope of claims 18-26. This means that the Examiner now should only have to conduct update searches. Applicants respectfully submit that the need to conduct update searches of classes already searched in the main does not qualify as a serious burden. Quite the contrary, it is the customary amount of work required when main searches have already been performed.

Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement. An early notice that the restriction requirement has been reconsidered and withdrawn is earnestly solicited.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By /Kurt G. Briscoe/
Kurt G. Briscoe
Attorney for Applicant(s)
Reg. No. 33,141
875 Third Avenue - 18th Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844